

## **REMARKS**

Claims 1, 5-11, and 20-39 are pending in the present application. Claims 8-10, 22, 23, and 31-34 have been withdrawn. Claims 1, 5, 6, 7, 11, 20, 24, 25, 26, 27 and 30 have been amended in this paper. Claims 35-39 are newly presented in this paper. Reexamination and reconsideration of the application are respectfully requested.

### **Rejections Under 35 U.S.C. § 112**

The Office Action rejected claims 1, 5, 6, 7, 11, 20, 21 and 24 under 35 U.S.C. § 112, first paragraph, as failing to comply with the written description requirement. The Office Action also rejected claims 1, 5, 6, 7, 11, 20, 21 and 24 under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. With respect to both of these rejections, the Office Action notes that the specification does not support the "entirely affixed" language in claim 1, for example.

The Applicants respectfully traverse this rejection, as Applicants have previously indicated where the support in the Specification appears. But, for reasons not related to this rejection, the "entirely affixed" language has been deleted from the claims. Consequently, Applicants respectfully request withdrawal of the rejections under 35 U.S.C. § 112, first and second paragraph.

### **Rejections Under 35 U.S.C. § 102(b) and § 103(a)**

The Office Action rejected claims 1, 5-7, 11, 20, 21 and 24 under 35 U.S.C. § 102(b) as being anticipated by Lenker et al. (U.S. Patent No. 5,843,158) or, in the alternative, under 35 U.S.C. § 103(a) as obvious over Lenker et al. in view of Kocur (U.S. Patent No. 6,350,277).

As background, Applicants' previously agreed to restrict the claims to pertain to embodiments as shown in Figures 9 and 10 of the present invention. Those Figures illustrate a system in which a bioabsorbable material extends about an endoprosthesis, such as a stent. (*See, e.g.*, Paragraph 11 of the present patent application, relating to bioabsorbable material). Fig. 9, for example, is a partial side view of a catheter assembly that includes a stent and a bioabsorbable material. The material may also be woven through openings in the stent structure, for example. Fig. 10 illustrates the same assembly, with the material 70 having become relaxed and/or has failed to allow the expandable member 24 to expand.

As described in the specification, the material may also optionally be coiled and/or bonded to the stent:

Such a material may be bonded to the delivery catheter and/or the stent, such as where a polymer material is heat-bonded in a tightly-coiled position around the stent. (see the application as published, pg. 2, par. 13, US Publication No. 2004/0133261)

The claims, as amended, now refer to an embodiment in which the material is a bioabsorbable material and in which the endoprosthesis is self-expanding. Neither of the cited references disclose a bioabsorbable material used to restrain a self-expanding endoprosthesis.

In particular embodiments, the material may be coiled about the prosthesis. The material may, for example, be heat bonded to the prosthesis or otherwise attached thereto. The material may be weakened in certain areas, to control a mode of failure of the material under sufficient pressure.

None of the references cited in the Office Action disclose such a system. That is, neither Lenker or Kocur disclose or suggest a system in which a bioabsorbable material is used to restrain expansion of an endoprosthesis. Neither Lenker or Kocur also disclose

further specific features recited in the dependent claims, as amended, such as for example:

- tightly coiled material that is bonded to the prosthesis (claim 5)
- endoprosthesis has an open-lattice configuration and the bioabsorbable material is threaded through open area(s) thereof (claims 6 and 26)
- material is thickest on the distal and proximal ends (claim 7, supported by Paragraph 49 of the published version of the present application)
- the bioabsorbable material has areas of varying strength to control failure of the material (claims 20 and 27). The areas of varying strength may be, for example, scoring, perforations and/or thinner diameter portions (claim 21)

As the cited references do not disclose or suggest features of the claims, as amended, withdrawal of the rejections under 35 U.S.C. § 102 and 35 U.S.C. § 103 is hereby requested.

With further regard to the obviousness rejections, it is also noted that it is improper to use the present specification and claims to envision the claimed invention in hindsight. The Patent Board has consistently held that it is not proper to use the present patent application as a template for an obviousness rejection: “We find no suggestion to combine the teachings and suggestions of [the cited references] as advanced by the Examiner, except from using Appellants’ invention as a template through a hindsight reconstruction of Appellants’ claims.” *Ex Parte Crawford et al*, Appeal 20062429, Decided May 30, 2007.

Further, an obviousness rejection must go into adequate detail in order to support the conclusion of obviousness. As the Federal Circuit wrote,

[R]ejections on obviousness grounds cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness. (*In re Kahn*, 441 F. 3d 977, 988 (CA Fed. 2006)).

For the foregoing reasons, including the absence of claim elements in any of the cited references, withdrawal of the obviousness rejection is respectfully requested.

### **New Independent Claims 35-39**

Claims 35-39 are added herein. Independent claims 35 and 39 combine features that are recited in other pending claims. None of the cited references teach or suggest the combinations of new claims 35-39. Allowance of claims 35-39 is respectfully requested.

### **Conclusion and Request for RCE**

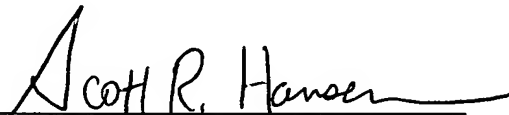
In view of the foregoing, it is respectfully submitted that all pending claims are now in condition for allowance. Reexamination and reconsideration of the application are respectfully requested and allowance at an early date is solicited.

The Office Action of May 22, 2008 is marked "Final." Consequently, the Applicants hereby request continued examination, and ask that this Response be treated as an **RCE**. The fee for an RCE is also submitted herewith.

A one-month extension of time to respond to the Office Action of May 22, 2008 is hereby requested.

The Commissioner is hereby authorized to charge any fees or costs due at present or in the future to our Deposit Account No. 06-2425.

Respectfully submitted,  
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